

PATENT APPLICATION

042390.P3275R

Remarks

Reexamination and reconsideration of this application is requested. According to the Office Action, claims 1-13 and 38-61 are pending in the application and that these claims were examined. Although Applicants filed an election to select a subset of these claims for examination in the response mailed June 24, 2003, Applicants are assuming the Examiner has decided to withdraw the requirement for restriction.

Response to the 35 U.S.C. §251 Rejection

The Office Action rejects claims 7, 12, 38, 41, 46, 49, 53, 56, and 59 under 35 U.S.C. §251 as being an improper recapture of broadening claimed subject matter surrendered in the application. Applicants respectfully traverse this rejection.

Applicant would point out that new claims 7, 12, 38, 41, 46, 49, 53, 56, and 59 were not prosecuted with the original patent. Thus, claims 7, 12, 38, 41, 46, 49, 53, 56, and 59 are not claims that represent subject matter that was abandoned by previous cancellation of claims.

Applicant further submits that the Courts have clearly stated "[t]he propriety of the recapture doctrine depends on certain factual determinations: 1) Are the reissue claims substantially identical to the abandoned claims? and 2) Were the critical limitations added or withdrawn at the insistence of the Patent Office. *Tee-Pak, Inc. v. St. Regis Paper Co.*, 181 USPQ 75 (6th Cir. 1974))

In the present case, claims 7, 12, 38, 41, 46, 49, 53, 56, and 59 were not presented in the original application that resulted in this patent and these claims are not substantially identical to any cancelled claims. Thus, Applicants respectfully submit that claims 7, 12, 38, 41, 46, 49, 53, 56, and 59 cannot satisfy either prong of the *Tee-pak* test.

PATENT APPLICATION

042390.P3275R

Lastly, The Court of Customs and Patent Appeals stated in *In re Wadlinger*, 181 USPQ 826 (CCPA 1974) that: "This court .. has made it clear that a reissue applicant is, at most, prevented by interpretations of the language of § 251 ... from obtaining claims which are of the same scope of the claims previously cancelled in the original application. As for obtaining claims on reissue which are different, no prohibition arises merely because of the language of the reissue statute. " (Emphasis added).

Applicants would like to point out that claims 7, 12, 38, 41, 46, 49, 53, 56, and 59 are clearly different than those in the original application. Thus, the CCPA makes clear that the Recapture Doctrine or § 251 cannot apply to these claims

Response to the 35 U.S.C. §102(e)/103(a) Rejection

The Office Action also rejects claims 1-13 and 38-61 either under 35 U.S.C. §102(e) as being anticipated or under 35 §103(a) as being obvious in view of Fung (US 5,710,929) and Fung (US publication 2002/0007463). Applicants respectfully traverse this rejection in view of the remarks that follow.

Applicant would like to point out that all rejections under 35 §102(e) and 35 §103(a) relied upon, at least in part, Fung (US publication 2002/0007463). However, Applicants respectfully submit that all such rejections are improper because the Examiner has not established that Fung (US publication 2002/0007463) is entitled to an effective priority date as a reference that at least predates the filing of the original filing of the present application. In addition, Applicants would respectfully submit that Fung (US publication 2002/0007463) is not entitled to a priority date of Fung (US 5,710,929).

PATENT APPLICATION

042390.P3275R

Applicants would like to respectfully point out that none of the drawings in Fung (US publication 2002/0007463) appear in Fung (US 5,710,929). Moreover, none of the tables shown in Fung (US 5,710,929) appear in Fung (US publication 2002/0007463). Consequently, Applicants respectfully submit that Fung (US publication 2002/0007463) contains new subject matter that is clearly not entitled to the priority date of Fung (US 5,710,929). More significantly, Fung (US publication 2002/0007463) does not have an effective priority date that predates at least the filing of the present application. Thus, Fung (US publication 2002/0007463) may not be relied upon, even in part, as the basis of a rejection under 35 §102(e) or 35 §103(a).

Applicants respectfully submit that the rejection of claims 1-13 and 38-61 is improper as such rejections rely upon a document that does not qualify as prior art under 35 §102(e) and 35 §103(a).

PATENT APPLICATION

042390.P3275R

Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed November 14, 2003 and it is submitted that claims 1-13 and 38-61 are in condition for allowance. Reconsideration of the rejection is requested.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #50-0221.

If the Examiner believes that there are any informalities that can be corrected by an Examiner's amendment, a telephone call to the undersigned at (480) 554-9732 is respectfully solicited.

Respectfully submitted,

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